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In the

Supreme Court of the United States

OCTOBER TERM, 1940

No.....

JAX ICE & COLD STORAGE COMPANY, a corporation, trading as JAX BREWING COMPANY,
Petitioner.

vs.

CONWAY P. COE, United States Commissioner of Patents, and JACKSON BREWING COMPANY, a corporation.
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

Jax Ice & Cold Storage Company, a corporation of the State of Florida, trading as Jax Brewing Company, prays for a writ of certiorari to review the judgment of the United States Court of Appeals for the District of Columbia entered on December 9, 1940.

OPINIONS BELOW

This matter was determined first by the District Court of the United States for the District of Columbia, without opinion, and, upon appeal, by the United States Court of Appeals for the District of Columbia, by *per curiam* decision of December 9, 1940, not yet reported.

JURISDICTION

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether Commissioner of Patents is a proper and adverse party in an equitable action, under Section 4915, *Revised Statutes*, Title 35, *U. S. Code*, Section 63, brought by a defeated applicant for cancellation to compel cancellation of a trade-mark registration.

STATUTES INVOLVED

The statutes involved are set out in the Appendix, *infra*, pp. 17, 18 and 19.

STATEMENT

Petitioner, a corporation of Florida, filed applications in the Patent Office for cancellation of two registrations of a single trade-mark in the name of respondent, Jackson Brewing Company, a Louisiana corporation, claiming ownership of the trade-mark in four Southeastern States. Its applications were summarily denied on motions of the registrant and it proceeded thereafter, under Section 4915, *Revised Statutes*, by bill in equity in the District Court of the United States for the District of Columbia, naming as defendants, the registrant, Jackson Brewing Company, and Conway P. Coe, Commissioner of Patents. A decree, adjudicating the rights of petitioner, requiring the delivery up by Jackson Brewing Company of its certificates of registration, and rectification of the Trade-Mark Register accordingly by the Commissioner, was prayed (R. 1 through 6).

Jurisdiction of the District Court for the District of Columbia was predicated upon Section 4915, *Revised Statutes* (Title 35, *U. S. Code*, Section 63); Section 9, *Trade-Mark Act of* 1905; (Title 15, *U. S. Code*, Section 89), and Section 72 a, Title 35, *U. S. Code*, the parties defendant residing in different judicial districts (R. 2 and 6).

The complaint was dismissed by the District Court on pleas by both defendants (R. 16 and 17), it being the contention of the Commissioner of Patents that he was not a proper party under the terms of Section 4915, *Revised Statutes*, and that the respondent, Jackson Brewing Company, a necessary party, was not subject to the jurisdiction of the District Court under the terms of Section 72 a, Title 35, *U. S. Code* (R. 12 and 13). It was the contention of Jackson Brewing Company that the Commissioner of Patents was not an adverse party and that jurisdiction of the District Court, under the terms of Section 72 a, Title 35, *U. S. Code*, was, therefore, lacking over it, a nonresident defendant (R. 11 and 12).

Appeal was taken from the judgment of the District Court to the Court of Appeals for the District of Columbia and by that Court affirmed, on December 9, 1940 (R. 22), the Court stating in a brief, *per curiam* decision: "This case is governed by *Coe v. Hobart Manufacturing Company*, 70 App. D. C. 2, 102 F. 2d, 270, and *J. C. Eno (U. S.) Limited v. Coe*, 70 App. D. C. 337, 106 F. 2d 858."

Both petitioner and respondent, Jackson Brewing Company, are owners and operators of breweries and both use the term "JAX" as a trade-mark for beer of

their manufacture and sale, petitioner confining its use to the States of Georgia, Florida, South Carolina and North Carolina (R. 3), and respondent confining its use to States other than those named (R. 3).

Petitioner adopted and first used the trade-mark in 1913 (R. 2). Respondent began its use in 1919 (R. 3), and thereafter effected two registrations of the mark in the Patent Office (R. 4).

In 1935, respondent began to invade the trade area of petitioner and as a result of threatened litigation petitioner and respondent entered into a written agreement wherein the rights of each to the trade-mark were recognized and whereby petitioner assigned the mark in all States other than Florida, Georgia, South Carolina and North Carolina to respondent, and respondent assigned the mark to petitioner in the States named (R. 5).

Petitioner has expended more than $500,000 in advertising its wares under the mark "JAX" (R. 3). Its sales have exceeded $2,000,000, and as a consequence thereof it is possessed of a valuable good will and business represented alone by its trade-mark "JAX" (R. 3). The term has come to mean, in the States of Georgia, Florida, South Carolina and North Carolina, the beer and near beer of petitioner (R. 3).

SPECIFICATION OF ERRORS TO BE URGED

The Court of Appeals erred:

1. In holding that the Commissioner of Patents is not a proper and an adverse party to an equitable action under Section 4915, *Revised Statutes*, brought by a de-

feated applicant for cancellation to compel cancellation of a trade-mark registration.

2. In holding that the District Court of the United States for the District of Columbia did not have jurisdiction of the respondent Jackson Brewing Company, under Section 72 a, Title 35, *U. S. Code,* when joined with Commissioner of Patents in equitable action under Section 4915, *Revised Statutes,* by defeated applicant for cancellation of trade-mark registration.

3. In holding that its decision was governed by the cases of Coe v. *Hobart Manufacturing Company,* 70 App. D. C. 2, 102 F. (2d) 270, and *J. C. Eno (U.S.) Limited v. Coe,* 70 App. D. C. 337, 106 F. (2d) 858, and that those cases should not be overruled.

4. In affirming the judgment of the District Court, dismissing the equitable complaint of petitioner for lack of jurisdiction over the respondent, Jackson Brewing Company.

REASONS FOR GRANTING THE WRIT

I.

CONFLICT WITH THIS COURT

The holding that the Commissioner of Patents is neither a proper nor an adverse party as contemplated by the terms and provisions of Section 4915, *Revised Statutes,* is contrary to the decision of this court in the case of *United States ex rel Baldwin v. Robertson, Commissioner,* 265 U. S. 168. It was in that case held that a defeated party in the Patent Office in a trade-mark matter could maintain, under the provisions of Section 4915,

Revised Statutes, a bill in equity against the Commissioner of Patents. Such a holding necessarily recognizes that the Commissioner of Patents, who is charged with the duty of maintaining in the City of Washington a register for the registration of trade-marks, and with protecting the purity and integrity of that register, in accordance with the terms and provisions of the statute establishing it, is a proper and an adverse party in an action affecting it.

II.

CONFLICT BETWEEN CIRCUITS

The decision of the Court of Appeals is in conflict with the decision of the United States Circuit Court of Appeals for the Sixth Circuit, in the case of *Cleveland Trust Co. v. Berry*, 99 F. (2d) 517, wherein that Court held the Commissioner to be a proper party in an equitable action under Section 4915, *Revised Statutes*, and in conflict with the decision of the United States Circuit Court of Appeals for the Third Circuit, in the case of *Drackett Co. v. Chamberlain Co.* 81 Fed (2d) 866, wherein that court expressly held that the Commissioner of Patents was a necessary party in an action under Section 4915, *Revised Statutes*, respecting the Trade-Mark Register. Furthermore, the decision of the Court of Appeals is in direct conflict with the following prior decisions of its own. *Alexandrine v. Coe, Commissioner*, 63 App. D. C. 227, 71 Fed. (2d) 348, and *Hygienic Products Co. v. Coe, Commissioner*, 66 App. D. C. 98, 85 Fed. (2d) 274, which it refused to follow.

III.

QUESTION OF GENERAL IMPORTANCE

The questions decided by the Court of Appeals, and which it is sought to review here, are of grave importance to the public generally, and particularly the industrial public. The principal statute involved, Section 4915, *Revised Statutes*, provides a remedy and relief to persons whose patent and trade-mark rights have been ignored or improperly dealt with by the Commissioner of Patents, and it is of paramount importance to the public to have this Honorable Court construe the statute involved to the end that persons may know what course to follow in the protection of their rights and that their valuable rights may not be lost because of indefiniteness and conflict in decisions of the lower courts, or because of the lower courts' failure to observe and follow the decisions of this Court.

Petitioner, in bringing its bill in equity in the District Court for the District of Columbia against the Commissioner of Patents and the Jackson Brewing Company, thought that it was following meticuously the procedure and course accorded it by the statutes in question, as interpreted by this Court in the case of *U. S. ex rel Baldwin v. Robertson, Commissioner, supra*, and by the Court of Appeals for the District of Columbia in the cases of *Alexandrine v. Coe, Commissioner, supra*, and *Hygienic Products Company v. Coe, Commissioner, supra*. If its action in this respect was improvidently taken as the Court of Appeals has held, it now has no further remedy since the time for further and different action on its part has expired.

CONCLUSION

For the reasons stated, it is respectfully submitted that this petition should be granted.

JAX ICE & COLD STORAGE COMPANY,

By Ernest P. Rogers

March, 1941. *Solicitor for Petitioner.*